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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,172	03/17/2006	Hitoshi Omori	ASAIN0178	3895
113 7590 07/11/2008 GRIFFIN BUTLER WHISENHUNT & SZIPL LLP SUITE PH-1 2300 NINTH STREET SOUTH ARLINGTON, VA 222042396				
EXAMINER RACHUBA, MAURINA T				
ART UNIT		PAPER NUMBER		
3723				
MAIL DATE		DELIVERY MODE		
07/11/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/595,172

Applicant(s)

OMORI ET AL.

Examiner

Maurina Rachuba

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,6-11 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,12,13 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12 May 2008 has been entered.

Election/Restrictions

2. Claims 3, 6-11, and 14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 13 August 2007. Applicant is strongly advised not to file any divisional applications until prosecution of this pending application is concluded, as any claims dependent from generic or linking claims will be examined when the generic or linking claims are deemed allowable.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 4, 5, 12, 13 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 now limits "the tool

body". There is no antecedent basis for "the tool body". Further, it is not clear if the tool body is the drum shaped tool, or the frame that holds the drum shaped tool.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hess et al, 4,958,463 in view of Nisimura, 3,953,942. '463 does not disclose the claimed tool comprising a driven gear disposed on both sides or on one side of the drum-shaped tool and a main driving gear disposed for driving the driven gear, wherein the main driving gear is belt-driven so as to rotationally drive the drum-shaped tool around the orthogonal axis x. In a similar apparatus, '942, figure 6, teaches driving a drum shaped tool by a driven gear disposed on one side of the drum-shaped tool and a

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main driving gear disposed for driving the driven gear, wherein the main driving gear is belt-driven so as to rotationally drive the drum-shaped tool around the orthogonal axis x. Because both references teach apparatus for rotating a grinding tool, it would have been obvious to one of ordinary skill in the art to substitute one drive system for the other to achieve the predictable result of driving the grinding tool. Further, regarding the limitation that the gears are disposed within the tool body, it is the examiner's position that '463 discloses providing its driving means within the tool body, in that the driving belt and pulleys are provided within the frame 16. It is also the examiner's position that '942 teaches its driving means disposed within the tool body, in that the driving means is disposed within a boundary formed by the sides of the arm.

7. Claims 5, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hess et al, 4,958,463, in view of Nisimura, 3,953,942, as applied to claims 1, 4 and 12, and further in view of Ohmori, 6,056,629. '463 does not expressly disclose that the grinding tool includes a metal in its bonding material, or correction means for correcting the machining surface, functioning simultaneously with the machining of the workpiece. In a similar apparatus, '629, teaches using a metal bonded grinding tool (column 3, lines 36-38), and correcting the grinding surface with correction means, simultaneously with machining the workpiece (column 4, lines 47-50). Using the known techniques of grinding with a metal bonded wheel, and correcting the surface of the wheel during machining of the workpiece, to provide the predictable result of maintaining the desired grinding wheel contour as taught by '629 would have been obvious to one of ordinary skill in the art.

Response to Arguments

8. Applicant's arguments with respect to claims 1, 4, 5, 12, 13 and 15 have been considered but are moot in view of the new ground(s) of rejection. Please refer to the rejections above, which address applicant's arguments filed 12 May 2008

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurina Rachuba whose telephone number is 571 272 4493. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571 272 4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. Rachuba/
Primary Examiner, Art Unit 3723

